

04 JUN 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Donald A. Shurr
Marshall & Melhorn
Four SeaGate - 8th Floor
Toledo, OH 43604

In re Application of :
JOEDICKE et al. :
Application No.: 09/914,082 :
PCT No.: PCT/DE00/00553 :
Int. Filing Date: 24 February 2000 :
Priority Date: 01 March 1999 :
Attorney Docket No.: 1-15478 :
For: ELECTROCHROMIC ELEMENT :

DECISION ON REQUEST
UNDER 37 CFR 1.497(d)

This decision is in response to "Request to Add Joint Inventor to Application under 37 CFR 1.48," which is being treated as a submission under 37 CFR 1.497(d) filed 11 March 2002.

BACKGROUND

On 24 February 2000, applicants filed the above-captioned international application, which claimed a priority date of 01 March 1999 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 September 2000. The international application named Dirk Joedicke, Hans-Joachim Becker, and Volker Gumprich as inventors. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 01 September 2001.

On 22 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee, a translation of the international application, and a preliminary amendment.

On 17 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a) and (b).

On 11 March 2002, applicants filed "Request to Add Joint Inventor to Application under 37 CFR 1.48" which included a declaration executed by Dirk Joedicke, Hans-Joachim Becker, Volker Gumprich, and Richard Batchelor.

DISCUSSION

In the instant case, the international application named Dirk Joedicke, Hans-Joachim Becker, and Volker Gumprich as inventors. Applicants request to add Richard Batchelor as an inventor. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a submission under 37 CFR 1.497(d) is required.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires:

- (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a);
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicants have satisfied item (1) through (3).

In regard to item (4) above, the written consent of the assignee is not acceptable. Firstly, the "Consent of Assignee to Add Joint Inventor to Patent Application" does not list the name of the individual signing on behalf of Flabeg GMBH. Secondly, the consent of assignee is executed by the Head of Research and Development and the petition does not aver that Head of Research and Development has the authority to provide consent for the assignee. Therefore, applicants are requested to file an additional written consent of the assignee that provides the name and title of the individual with authority to act on behalf of the assignee. Section 201.03 of the M.P.E.P states in part that:

"The title of the party signing on behalf of a corporate assignee and the authority to do so should be set forth in the written consent. Consent of a corporate assignee may be signed by an officer (e.g., president, vice president, secretary, or treasurer) of the corporation or may include a statement in oath or declaration form that the person signing the consent has authority to do so. Further the assignee must establish its ownership of the application in accordance with 37 CFR 3.73."

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b). Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Attorney-Advisor
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459